

## **REMARKS**

### **I. Amendments**

By this amendment, claims 1, 4 and 11 have been amended.

This amendment adds no new matter to the specification. Support for the amendment may be found in the specification and claims as originally filed.

No amendment of inventorship is necessitated by this amendment.

### **II. Status of Claims**

In the Advisory Action, no box was checked under item 7 to indicate whether or not the previous amendments to the claims have been entered. As the previous response was indicated to have overcome some of the rejections, Applicants have assumed that the previous amendment was entered. Should the previous amendment not have been entered, Applicants respectfully request that the Examiner inform them of the claim status.

Applicants respectfully request that the Examiner clarify the status of claims 7 and 25. These are independent claims. Applicants do not believe that there are still any outstanding rejections for these claims, so they believe that they should have been listed as allowable in the Advisory Action. If the Examiner has a reason to maintain rejection of these claims, the Examiner is respectfully requested to indicate the rejection.

Applicants also note that claims 5, 6, 22, 23 and 50 were cancelled by the previous amendment, though they were listed as rejected in the Advisory Action.

Appropriate clarification and/or correction is respectfully requested.

### **III. Status of the Previous Non-Statutory Double Patenting Rejection**

The Advisory Action did not advise whether or not the previously submitted Terminal Disclaimer overcame the outstanding non-statutory double patenting rejection. Applicants respectfully request that the Examiner inform them if the previous non-statutory double patenting rejection has not yet been overcome.

**IV. Discussion of the Rejection under 35 U.S.C. Sec. 103(a) over WO 98/11884 and Russell *et al.* (MEDLINE AN 97386874) in view of Biosis AN 1997:356824**

The rejection under 35 U.S.C. Sec. 103(a) over WO 98/11884 and Russell *et al.* (MEDLINE AN 97386874) in view of Biosis AN (1997: 356824) has been maintained. Applicants respectfully traverse the rejection.

By this amendment, independent claim 1 has been modified to recite specific insulin sensitizers. This amendment adds no new matter to the specification. Support for the amendment may be found at page 17, line 27 – page 18, line 5 *inter alia*. Dependent claims 4 and 11 were also modified in accordance with the modification to their related independent claim.

Applicants believe that the amendment to claim 1 renders it non-obvious over the combined teachings of the cited reference, when Examiner Cook's statements found on page 3, paragraph 3 and page 6, paragraphs 4 and 5 of the Office Action dated December 5, 2005 regarding the previously submitted supporting Declaration and Example 1 in the instant specification are considered. Applicants further believe that rosiglitazone (recited in claim 1 as amended) is included in the "(Pioglitazone and) structurally related insulin sensitizers" implicated for acceptance by the Examiner Cook because pioglitazone and rosiglitazone share a pyridine structure and an ethoxy-benzyl-2,4-thiazolidinedione structure as shown on page 17, line 29-36 of the instant specification.

Claims 4, 11, 24, 26 and 27 depend upon claim 1. Applicants submit that the more specific dependent claims are also non-obvious over the combined teachings of the cited references for the reason provided above.

Therefore Applicants respectfully request withdrawal of the 35 U.S.C. Sec. 103(a) rejection over WO 98/11884 and Russell *et al.* (MEDLINE AN 97386874) in view of Biosis AN (1997: 356824).

**V. Discussion of the Rejection under 35 U.S.C. Sec. 103(a) over MEDLINE AN 1998152487 and WO 93/03724 in view of Biosis AN 1997:356824**

The rejection under 35 U.S.C. Sec. 103(a) over MEDLINE AN 1998152487 and WO 93/03724 in view of Biosis AN (1997: 356824) has been maintained. Applicants respectfully traverse the rejection.

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Applicants believe that the amendment to claim 1 renders it non-obvious over the combined teachings of the cited reference, when Examiner Cook's statement found on page 3, paragraph 3 and page 6, paragraph 4 and 5 of the Office Action dated December 5, 2005 regarding the previously submitted supporting Declaration and Example 1 in the instant specification are considered. Applicants further believe that rosiglitazone (recited in claim 1 as amended) is included in the "(Pioglitazone and) structurally related insulin sensitizers" implicated for acceptance by the Examiner Cook because pioglitazone and rosiglitazone share a pyridine structure and an ethoxy-benzyl-2,4-thiazolidinedione structure as shown on page 17, line 29-36 of the instant specification.

Claims 4, 11, 24, 26 and 27 depend upon claim 1. Applicants submit that the more specific dependent claims are also non-obvious over the combined teachings of the cited references for the reason provided above.

Therefore Applicants respectfully request withdrawal of the 35 U.S.C. Sec. 103(a) rejection over MEDLINE AN 1998152487 and WO 93/03724 in view of Biosis AN (1997: 356824).

## VI. Conclusion

Reconsideration of the pending claims as amended is requested.

Should the Examiner believe that a conference with Applicants' attorney would advance prosecution of this application, he is respectfully requested to call Applicants' attorney at (847) 383-3391.

Respectfully submitted,

Dated: May 17, 2006

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